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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/538,227

06/08/2005

Klaus Werner Leitner

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EXAMINER

MERCADO, JULIAN A

ART UNIT

PAPER NUMBER

1795

NOTIFICATION DATE

DELIVERY MODE

09/22/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usptopatentmail@cantorcolburn.com

Office Action Summary	Application No. 10/538,227	Applicant(s) LEITNER ET AL.	
	Examiner JULIAN MERCADO	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :July 16, 2009, the IDS of September 19, 2008, the IDS of May 30, 2008, the IDS of April 9, 2008 and the IDS of November 7, 2005.

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DETAILED ACTION

Election/Restrictions

Claims 1-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on April 7, 2009.

Claims 13-22 are pending for consideration.

Information Disclosure Statement

The Information Disclosure Statement (IDS) filed on July 16, 2009, the IDS of September 19, 2008, the IDS of May 30, 2008, the IDS of April 9, 2008 and the IDS of November 7, 2005 have been considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 recites the limitation "titan" in line 3, which is not understood. At best, it appears to the examiner that "titan" is intended to be a titanium-based material, however, page 3

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line 33 of the specification also recites a "titan" material and no other explicit support in the specification has otherwise been found.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 13-19 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Besenhard et al. (U.S. Pat. 5,916,485).

For claim 13-16, Besenhard et al. teaches a method of preparing an electrode substrate comprising a step of preparing a layer of conductive material such as carbon black onto the surface of a metal electrode substrate. The examiner notes the scope of claim 13 reciting an active material, conductive material or composite thereof in the alternative. Thus, Besenhard et al.'s disclosure of carbon blacks by SIC (substrate-induced coagulation) coating method anticipates the claims. See col. 2 line 7 et seq. and col. 5 line 19 et seq.

For claims 17 and 18, the SIC method further comprises a conditioning step with a cationically charged polyelectrolyte, *inter alia*, stabilized with wetting agents, i.e. surfactants. Ib. and col. 6 line 7 et seq. As the conditioning step is specifically disclosed as a pre-condition step or coagulation trigger, it naturally flows that the conditioning step occurs prior to treating the substrate with the conductive material.

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For claim 19, the cationically charged polyelectrolyte is a "polyelectrolyte based on acrylamide."

For claim 22, Besenhard et al. specifically discloses the electrode as used in a battery.
See col. 7 line 19 and col. 8 line 1 et seq.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Besenhard et al. (U.S. Pat. 5,916,485).

The teachings of Besenhard et al. are discussed above.

Besenhard et al. does not explicitly teach the w/w % of the polyelectrolyte or the amounts of material contained in the dispersion. However, it is asserted that determining where the optimum combination of percentages (such as the w/w % or other measure of the percent amount of material) lies is prima facie obvious. *In re Peterson*, 315 F.3d 1325, 1330, 65 USPQ 2d 1379, 1382-83 (Fed. Cir. 2003); see also *In re Geisler*, 116 F.3d 1465, 1470, 43 USPQ 2d 1362, 1365 (Fed. Cir. 1997) ("[I]t is not inventive to discover the optimum or workable ranges by routine experimentation." (quoting *In re Aller*, 220 F.2d 454, 456, 105 USPQ 223, 235 (CCPA 1995))).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Pat. 7,566,479 to Besenhard et al. is cited of cumulative relevance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian Mercado whose telephone number is (571) 272-1289. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan, can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

/Julian Mercado/
Examiner, Art Unit 1795

/PATRICK RYAN/
Supervisory Patent Examiner, Art Unit 1795